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09/423,511	11/10/1999	HANS SJOBLUM	003300-592	6824

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,511

Applicant(s)

SJOBLOM, HANS

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 18.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 1-29 are pending. Claim 1 has been amended.

Response to Arguments

2. Applicant's arguments filed December 5, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Barlow (U. S. Patent 6,038,551) fails to teach user creates the transaction message on the basis of entered transaction information in the smart card with the aid of software previous stored in the smart card, Barlow teaches this matter, in particular at column 14 lines 62 – column 15 line 10; Barlow teaches a user selecting beverage which corresponds to create a transaction message, and the IC card are used for this beverage transaction which corresponds to the usage of the smart card as claimed.

Applicant further argues that Barlow fails to teach the user has no interaction with a communication network during the creation of the message. On page 5 lines 6-12 of the application, applicant states "the transaction message is created preferably without connection to the communications network or off-line", which elucidates the citation in claim 1, "independently of any connection to a communications network and without computer dialogue with a receiver". The vending machine purchase in Barlow's teaching (column 14 lines 62 – column 15 line 10) corresponds to this limitation because Barlow explicitly states "the vending machine is an example of an offline computer".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 11-13, 15-18, 21-23 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Barlow et al., U. S. Patent 6,038,551.

As to claim 1, Barlow teaches a method for performing electronic transactions, in which a sender of transaction messages is assigned a smart card with an associated unique identity and a private key stored in the card in a protected manner, and in which an associated public key is kept generally available, characterised in that in connection with an electronic transaction under the sender's own control, preferably through his own input of message information, the sender, independently of any connection to a communication network and without computer dialogue with a receiver, creates, on the basis of entered transaction information, a transaction message, which contains information necessary for the transaction, the transaction message being created in the smart card with the aid of software previously stored in the smart card, and, in his smart card, provides the created transaction message with his digital signature while using his own private key for subsequent output and transmission of the transaction message (column 13 lines 20-39 and column 14 lines 5 – column 15 line 10 and Figs. 3, 5, 7-10;

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specifically, at column 14 line 62 – column 15 line 10, Barlow teaches the user uses the IC card to make an offline purchase, such as a purchase from a vending machine; that is an example of creating a transaction message by a sender without communications network dialogue).

As to claim 2, Barlow teaches characterised in that the transaction message contains information on sender, receiver, amount and preferably a transaction serial number (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claims 3-4, Barlow teaches the transaction message is created off-line (column 14 line 61 – column 15 line 10).

As to claim 5, Barlow teaches characterised in that the transaction message is created in the smart card (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 6, Barlow teaches characterised in that the transaction message is created with the aid of software inserted in the smart card in advance and preferably also sender information inserted in the card in advance (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 7, Barlow teaches characterised in that information required for the transaction message is input with the aid of input means arranged on the smart card, the card preferably being a so-called advanced smart card (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 8, Barlow teaches characterised in that information necessary for the transaction message is input with the aid of a protected card terminal (column 15 lines 47-52 and Figs. 3-5).

As to claim 9, Barlow teaches characterised in that information necessary for the transaction message is input with the aid of a separate card communication unit, the latter preferably also being a card activator (Figs. 1-2).

As to claim 11, Barlow teaches characterised in that the transaction message contains sender information in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 12, Barlow teaches characterised in that the transaction message contains receiver information in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 13, Barlow teaches characterised in that the signed transaction message is sent to a card or account administrator regarding the sender or receiver, that the digital signature of the transaction message is authenticated by using the public key, which is assigned to the one who is identified as sender by the transmitted transaction message, and that in case of authenticity, the receiver is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 15, Barlow teaches characterised in that the signed transaction message is encrypted by using a public key belonging to the addressee, to whom the transaction message is sent, that the encrypted, signed transaction message is sent to

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the addressee, that the addressee by using his private key decrypts the signed transaction message, that the digital signature of the transaction message is authenticated by using the public key which is assigned to the one who is identified as sender by the transmitted transaction message, and that the receiver, in case of authenticity, is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 16, Barlow teaches characterised in that the addressee is the receiver, that the receiver, after decryption, sends the signed transaction message to a card or account administrator, whereupon said authentication takes place (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 17, Barlow teaches characterised in that the signed transaction message is encrypted by using the sender's public key and is provided with sender information and is then sent to a card or account administrator, who has the sender's private key and who preferably has issued the user's smart card, that said administrator decrypts the received encrypted message by using said private key, that authentication of the digital signature of the decrypted transaction message takes place by using the public key, which is assigned to the one who is identified as sender by the transmitted transaction message, and that the receiver, in case of authenticity, is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 18, Barlow teaches characterised in that the signed transaction message is sent non-encrypted, especially via a public communications network, such as the Internet or a telecommunications network (column 15 lines 11-17).

Claims 21, 23 and 26 are rejected for the similar reasons as claims 1 and 13.

Claims 22 and 28 are rejected for the similar reason as claim 7.

Claim 25 is rejected for the similar reason as claim 9.

Claims 27 and 29 are rejected for the similar reason as claims 3-4.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551.

As to claim 14, Barlow teaches the signed transaction message is first sent to the receiver (column 14 lines 5-61 and Figs. 3, 5, 7-10). Barlow does not specifically teach optionally forwards the signed transaction message to said card or account administrator. It would have been obvious to one of ordinary skill in the art to allow the system of Barlow to include the feature of forwarding the signed transaction message to his/her smart card or account administrator so that the transaction can be better tracked.

7. Claims 10, 19-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551 in view of Heinonen et al., U. S. Patent 5,887,266.

As to claims 10, 19-20 and 24, Barlow does not specifically teach the telecommunication unit is a mobile telecommunication unit such as mobile phone. However, Heinonen teaches a mobile telecommunications unit such as a mobile phone controlled by the smart card and SMS service is used for communicating data message (column 1 lines 11-37 and column 2 lines 17-42 and column 3 lines 1-10 and Fig. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the telecommunication unit of Barlow to include features as taught by Heinonen so that user can remotely transmit or access messages.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")
(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
March 15, 2004



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